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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,485	07/06/2001	Rod A. Cherkas	37202/102001; 990006	4159
7590	06/20/2007		EXAMINER	
Robert P. Lord OSHA - LIANG LLP Suite 2800 1221 Mckinney Street Houston, TX 77010			CHENCINSKI, SIEGFRIED E	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/900,485	CHERKAS ET AL.
	Examiner	Art Unit
	Siegfried E. Chencinski	3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 5, 2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-26 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wallman (US Patent 6,161,098).

### **COMMENTS:**

a) Each tax program is focused on one tax year because the tax laws and regulations change for each tax year. This also means that, especially for "small investors", evaluations for the currently active tax year have to be done using the prior year's tax program until the Congress and the IRS have locked in the tax law and regulations for the tax year and the tax software providers have distributed the new tax software for purchase. Often this only occurs during the following January after the tax year has passed and no transactions affecting the tax year are possible. However, some known or likely revisions may be able to be simulated through adjustments in appropriate fields.

b) By definition, a tax return is confined to one tax year, so tax information is inherently related to each separate year. Thus a given tax return concerns itself with a single year. Also a tax return is synonymous with one tax year of the user. The current tax year's information is all "pro-forma" or estimated or proposed. Past year's tax information is more permanent, but is subject to revisions until the initial tax return for a given tax year is filed, but is then subject to amendments if the taxed person chooses to submit such revisions, and is also subject to later challenges and revisions by the IRS.

**Re. Claim 1,** Wallman discloses a computer implemented method of determining the consequences of an investment transaction to a potential total tax liability of a user, the method comprising:

- storing for the user a tax profile containing tax return data for at least one tax year of the user (Database – Fig. 3; Col. 3, l. 14; Col. 6, ll. 6-12; Col. 13, ll. 19-33. The stored tax profile containing the tax return data is inherent.);
- accessing the tax profile of the user to obtain tax return information relevant to determining the user's total tax liability in a current tax year (Col. 3, ll. 35-38; Col. 5, l. 65 – Col. 6, l. 12; Col. 6, ll. 13-21. The impact on the current tax year is inherent, since it is implicit that the sell/buy action decisions taught by Wallman are for the current year, especially the very near term, such as the same day, or a short period beyond that.); and
- Providing the user with a potential total future tax liability of the user based on a proposed brokerage transaction and the tax return information from the tax profile (Col. 2, ll. 63-67; Col. 3, ll. 35-38; Col. 7, ll. 20-24. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material.).

Wallman does not use the expression "total future tax liability". However, in fact Wallman discloses the same thing in equivalent language. Wallman discloses a method and system which enables a user to determine his total potential tax liability for a given year such as the current year by enabling the user to combine all of his

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taxable activities, i.e. all of his sources of income, beginning with employment income, and then using his method and system to test what-if scenarios regarding his existing investments and prospective investments. Wallman's disclosure concerns itself with both short term (current tax year) and long term (over one year ending in the current tax year or in a future tax year) (Col. 2, ll. 49-52). Thus Wallman concerns himself with assisting the small investor individual in managing his total future tax liabilities.

Examples of his disclosure which demonstrates this are the following: a) Overall tax results, including income taxes (Col. 2, ll. 44-48; Col. 15, l. 12) and b) various other taxable transactions listed in Col. 15, ll. 9-23: brokerage transactions which result in short and long term capital gains (l. 10-11), and transactions which include foreign or domestic securities, equities, options, mutual fund shares, bonds, etc. (ll. 17-18).

Wallman does this through a "system for managing the portfolio of securities enabling the investor easily to make a selection and place an order as to the desired cash and tax results". (Col. 2, ll. 65-67).

Therefore an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used Wallman's disclosure in order to establish a computer implemented method of providing potential future tax liability for a user based on a proposed brokerage transaction and the tax return information from eh tax profile, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

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**Re. Claim 2,** Wallman discloses:

- storing a brokerage account of the user in which the proposed brokerage transaction is to be entered (Col. 3, ll. 14-16; Col. 6, ll. 6-12. Storing is implicit); and
- linking the brokerage account of the user to the tax profile of the user for obtaining the tax return information to determine the potential total future tax

liability (Col. 2, ll. 63-67; Col. 3, ll. 35-38; Col. 5, l. 65 – Col. 6, l. 5; Col. 7, ll. 20-24. The linkage is inherent.).

**Re. Claim 3**, Wallman discloses a method wherein the brokerage account is stored in a brokerage account database, and the tax profile is stored in a tax profile database that is physically separate from the brokerage account database (Col. 3, ll. 14-17; Col. 6, ll. 6-12. Separate storage of each is implicit.).

**Re. Claim 4**, Wallman discloses a method comprising:

determining a potential total future tax liability of the user in the absence of the proposed transaction; and providing the user the potential total future tax liability from the proposed transaction in comparison with the potential total future tax liability in the absence of the proposed transaction (This is inherent in Wallman's teaching because this is at the core of Wallman's method wherein the comparison is made between the tax consequence of no action versus the tax consequences of various possible asset sale actions. Col. 6, ll. 50-66).

**Re. Claims 5 & 18**, Wallman has been discussed above. Wallman discloses providing the user with a potential total future tax liability of the user based on the proposed transaction and the tax return information from the tax profile.

Wallman also discloses or suggests

- **Re. Claim 5**, accessing prior completed transactions of the user relevant to the current tax return of the user; and determining the potential total future tax liability from the prior completed transactions, the tax return information, and the proposed transaction in Col. 6, ll. 50-57.
- **Re. Claim 18**, determining the potential total future tax liability based on the proposed transaction, the tax return information from the user's tax profile; and previously executed transactions effecting tax liability in the current tax year (Col. 6, ll. 50-57).

Wallman discloses interacting "with a program that calculates the taxable effect of a transaction based on other taxable transactions, income and other taxable items known to the user or expected to be engaged in by the user, either as stored in a program such as Intuit's Turbo Tax ® or other wise inputted into the program by the

user". Applicant only includes two references to these limitations in the disclosure, one being this claim 5, and the other being in specification section [0031] on page 7, line 11 ("previous transactions already completed"). The practitioner would have known that such transactions include prior asset sales during the current tax year, possible tax credits from prior tax year transactions, the current tax year's tax liability by the next quarterly estimated tax payment deadline and the next April 15<sup>th</sup> filing and payment deadline; and potential future tax liabilities or tax credits resulting from asset sale transactions during the current tax year. The ordinary practitioner would have understood tax regulations sufficiently to know that "prior completed transactions of the user relevant to the current tax year of the user".

**Re. Claims 5 and 18:**

It would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosures of Wallman with a basic understanding of individual tax return options in order to offer an automated method for calculating potential total future tax liability based on a proposed transaction and tax return information, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

**Re. Claim 6**, Wallman discloses a method wherein the stored tax profile comprises a user's tax filing status, income information, and deduction information. (Col. 6, ll. 6-12). This is inherent because a tax payer's tax filing status, income and deduction information have been standard data components of tax return information for many decades, and are data elements which impact the tax payer's tax formula.

**Re. Claim 7**, Wallman discloses a method wherein the stored tax profile comprises the user's marital status, home ownership status, and dependent information. (Col. 6, ll. 6-12). This is inherent because a tax payer's marital status, home ownership status, and dependent information have been standard data components of tax return information for many decades, and are data elements which impact the tax payer's tax formula.

**Re. Claims 8-11 & 13**, Wallman does not explicitly disclose:

**Re. Claim 8**, wherein items of tax return information in the user's tax profile are mapped to fields on computer representations of tax forms used to compute tax liability (Wallman discloses the importing of tax return information from a tax program to identify potential tax savings from engaging in a transaction involving any of the capital assets in a database. It would have been obvious to the ordinary practitioner that the user's tax profile are mapped to fields on computer representations of tax forms used to compute tax liability because that is a well known technique in the computer software utilization process).

**Re. Claim 9**, wherein the tax profile stores tax return information for a plurality of prior tax years (This is implicit and well known as a feature of standard tax programs such as those referenced in the disclosure – Col. 6, ll. 6-12).

**Re. Claim 10**, wherein the tax profile stores tax return information for alternative scenarios of the current tax year (This was obvious and well known to the ordinary practitioner at the time of Applicant's invention. Alternative scenarios have been a standard feature of tax programs prior to Applicant's invention.).

**Re. Claim 11**, wherein the tax profile stores tax return information at a plurality of levels of granularity to allow for adaptation of tax data from external data sources. (Granularity is an expression whose computer industry usage means "from coarse to fine, of a computer activity or feature in terms of the size of the units it handles (e.g. - sets of data). The larger the pieces, the coarser the granularity. Microsoft Computer Dictionary). Multiple levels of granularity to allow for adaptation of tax data from external data sources were well known elements in the database management process at the time of Applicant's invention.

**Re. Claim 13**, receiving the user's tax profile from a direct manual input by the user. However, Wallman discloses the user inputting information from his own records (Col. 3, ll. 16-17, Col. 6, ll. 15-18). It would have been obvious to the practitioner to have provided the option of permitting or enabling the user to enter the user's tax profile by a direct manual input by the user.

**Re. Claims 8-11 & 13**, it would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosures of Wallman with

a basic understanding of individual tax return options in order to offer an automated method for calculating potential total future tax liability based on a proposed transaction and tax return information, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

**Re. Claim 12,** Wallman discloses a method wherein the tax profile stores for each investment, information from which an acquisition price, an acquisition date, a sale price, a sale date, a holding period, and a gain or loss can be computed. (Col. 4, ll. 28-33, 56-66).

**Re. Claim 14,** Wallman discloses a method importing data for the user's tax profile from file generated by a tax preparation software application (Col. 6, ll. 6-12).

**Re. Claim 15,** Wallman discloses a method responsive to the user executing the proposed transaction, updating the tax profile to reflect the proposed transaction (Col. 5, l. 65 – Col. 6, l. 5).

**Re. Claim 16,** Wallman discloses a method wherein providing future tax liability data to the user further comprises: providing an amount of the total future tax liability to the user (Col. 3, ll. 36-48).

**Re. Claim 17,** Wallman discloses a method of providing an amount of the marginal tax owed or saved from the proposed transaction (Col. 3, ll. 36-48. It is implicit in Wallman that the tax owed or saved is shown).

**Re. Claim 19,** Wallman discloses a computer implemented method of determining tax liability, the method comprising:

- storing for a user a tax profile containing tax return data for at least one tax return of the user (Database – Fig. 3; Col. 3, l. 14; Col. 6, ll. 6-12; Col. 13, ll. 19-33. The stored tax profile containing the tax return data is inherent);
- receiving a plurality of proposed investment transactions from the user to be executed in a group (Col. 2, ll. 65-67; Col. 3, ll. 21-24, 35-37, 42-45);

- accessing the tax profile of the user to obtain tax return information relevant to determining the user's total tax liability in a current tax year (Col. 6, II. 6-12, 15-21, 40-49; Col. 3, II. 37-42);
- determining a potential total future tax liability of the user based on all of the proposed transactions and the tax return information from the tax profile (Col. 6, II. 40-49. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material.); and
- providing the potential total future tax liability to the user (Col. 3, II. 53-56, 65-67).

**Re. Claim 20,** Wallman discloses a computer implemented method of determining tax liability, the method comprising:

- storing for a user a tax profile containing tax return data for at least one tax return of the user (Database – Fig. 3; Col. 3, I. 14; Col. 6, II. 6-12; Col. 13, II. 19-33. The stored tax profile containing the tax return data is inherent);
- receiving a plurality of separate proposed investment transactions from the user, each investment transaction to be executed independently (Col. 2, II. 63-67; Col. 3, II. 23-24, 35-38, I. 59 – each potential trade, I. 66 – each asset/liability; Col. 4, II. 12-14 – which of the securities must be sold – this must be either a single, independent transaction or a group or multiple transaction, as determined by the user . The seller's instructions necessarily include a transaction to be executed independently.);
- accessing the tax profile of the user to obtain tax return information relevant to determining the user's total tax liability in a current tax year (Col. 6, II. 6-12, 15-21, 40-49; Col. 3, II. 37-42);
- for each proposed investment transaction, determining a potential total future tax liability of the user based on the proposed transaction and the tax return information from the tax profile (Col. 6, II. 50-57. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material.); and

- providing the potential total future tax liability for each proposed investment transaction to the user (Col. 3, ll. 53-56, 65-67).

**Re. Claim 21,** Wallman discloses a method of determining the proposed investment transaction that has the best overall tax consequences for the user (Col. 4, ll. 1-14; Col. 6, ll. 40-57.).

**Re. Claim 22,** Wallman discloses a system for determining a total future tax liability of a user for a proposed investment transaction, comprising:

- tax profile database adapted to store tax profiles for users, each tax profile including tax return information for the user (Database – Fig. 3; Col. 3, l. 14; Col. 6, ll. 6-12; Col. 13, ll. 19-33. The stored tax profile containing the tax return data is inherent);
- a brokerage interface adapted to receive a proposed transaction from the user (Col. 3, l. 15, 23-28; Col. 7, ll. 8-11, 41-48); and
- a tax engine adapted to receive the proposed transaction and coupled to obtain the tax return information from the tax database, and further adapted to calculate the potential future tax liability of the user based on the proposed transaction and tax return information (Col. 7, ll. 20-26; Col. 6, ll. 6-12. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material.).

**Re. Claim 23,** Wallman discloses an account database adapted to store user's brokerage accounts, each user brokerage account linked to the user's tax profile in the tax profile database (Col. 3, ll. 13-16; Col. 5, l. 65 – Col. 6, l. 5).

**Re. Claim 24** Wallman discloses a user interface for a computer system that determines tax liability, the user interface being provided by a computer program encoded on a computer media usable by the computer system, the user interface comprising:

- a first window for receiving at least one proposed investment transaction entered by a user (Col. 3, ll. 1-9. The first window is inherent – see pop-up window, Col. 7, l. 3);

- a control for executing, in response to selection by the user, a determination of a potential future tax liability of the user from the proposed transaction using tax return information of the user stored in a tax profile (Col. 3, ll. 21-28, 53-63. The control is inherent. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material.); and
- a second window for displaying the total potential future tax liability of the user, as a consequence of the proposed transaction (Col. 4, ll. 1-9. The second window is inherent).

**Re. Claim 25 & 26:**

**Re. Claim 25,** Wallman discloses use of an interface to display:

- any capital gains or losses from the proposed transaction (Col. 4, ll. 56-65);
- any short term gains or losses from the proposed transaction (Col. 4, ll. 56-65);

Wallman does not explicitly disclose displaying:

- a total income to the user after the proposed transaction;
- a tax rate applicable to the user as a consequence of the proposed transaction; and
- the potential future tax liability of the user as a consequence of the proposed transaction.

However, Wallman discloses and/or suggests a system and interfaces which displays all the income and taxation consequences of potential and proposed asset transactions (Col. 15, ll. 5-23). All other facets related to the management of a user's total tax consequences are disclosed in Col. 6, l. 40 – Col. 7, l.6. This includes the implicit consideration of total income, both regular income from other sources and from asset trading and also from long term capital gains, potential marginal tax rates, implied resultant total tax rates using off the shelf tax programs and an "expert agent" for managing (the) tax effects ... (which) monitors the user's tax position by comparing the capital gains effects from various proposed or available transactions' (Col. 6, ll. 58-65).

**Re. Claim 26,** Wallman discloses using a window to display:

- any capital gains or losses before the proposed transaction (Col. 4, ll. 57-65);
- any short term gains or losses before the proposed transaction (Col. 4, ll. 57-65);

Wallman does not explicitly disclose displaying:

- a total income to the user before the proposed transaction;
- a tax rate applicable to the user prior to the proposed transaction; and
- a total tax owed by the user prior to the proposed transaction.

However, Wallman suggests the display of:

- a total income to the user before the proposed transaction;
- a tax rate applicable to the user prior to the proposed transaction; and
- a total tax owed by the user prior to the proposed transaction;

because Wallman discloses and/or suggests a system and interfaces which displays all the income and taxation consequences of potential and proposed asset transactions (Col. 15, ll. 5-23). All other facets related to the management of a user's total tax consequences are disclosed in Col. 6, l. 40 – Col. 7, l.6. This includes the implicit consideration of total income, both regular income from other sources and from asset trading and also from long term capital gains, potential marginal tax rates, implied resultant total tax rates using off the shelf tax programs and an "expert agent" for managing (the) tax effects ... (which) monitors the user's tax position by comparing the capital gains effects from various proposed or available transactions' (Col. 6, ll. 58-65).

**In conclusion, Re. Claim 25 & 26:** It would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosures of Wallman with a basic understanding of individual tax return options in order to offer an automated method for calculating potential total future tax liability based on a proposed transaction and tax return information, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-26 received on April 5, 2007 have been fully considered but they are not persuasive.

**ARGUMENT:** Applicant argues that the examiner has failed to establish a *prima facie* case of obviousness in rejecting "the claims" (p. 9, ll. 4-5, presumably the entire set of claims 1-26, with the arguments focusing on the rejection of independent claims 1, 19, 20, 22 and 24 – p. 11, ll. 2-3), on the basis that "... because Wallman does not consider overall tax information of a user in computing tax liability of a user, it is not possible for Wallman to provide a user with a *total* future tax liability. At best, Wallman provides a user with the tax consequences directly related to one or more securities transaction in which the user engages" (p. 10, ll. 18-21).

**RESPONSE:**

1. Applicant is not claiming to have invented a new way of doing pro forma tax liability analysis or related new tax loop hole.
2. Wallman explicitly discloses the identification and calculation of "overall tax results" (Col. 2, l. 46).
3. The ordinary practitioner of pro forma tax evaluation would have been knowledgeable in how to properly compute a pro forma tax liability and the impact of a particular contemplated course of tax impacting transactions. This means and implies computing the new total future tax liability, comparing it to the future tax liability for the same future tax period without the contemplated action, and taking the difference, which is the tax liability of the proposed action. While asking the total new future tax liability without comparing it to the future tax liability is a piece of information, the art does not consider this to be the legitimate answer to the impact of the action. However, computing the new total future tax liability is part of the proper analysis.
4. In an obviousness rejection under 35 USC 103(a), what is suggested to the ordinary practitioner is the key. The Federal Circuit Court reiterated the criticality of this point in their ruling in March, 2006 in the case of *In Re Kahn*, as follows:

"A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or

suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

5. Thus, unlike in the case of chemical and physical reactions when combinations are made which must obey narrow proven physical phenomena, software designs can be taken in pieces according to the ordinary practitioner's need. Courts have ruled that such facts of the circumstances must be carefully considered in determining what the ordinary practitioner would have seen in solving his problem based on disclosures in the prior art.

6. In this instance, is important to consider what the ordinary practitioner would have known at the time of Applicant's invention. Applicant would have been proficient in the art of pro forma tax impact analysis as it applies to the tax laws, and the user would have been similarly proficient in tax analysis applying to the tax jurisdictions which apply to the tax payer or tax paying entity involved in the analysis.

Therefore, the examiner has met the standards reconfirmed by *In re Kahn* stated above. The examiner has pointed to a combination of explicit, implicit, suggested and obvious reasons, and to the knowledge of the ordinary practitioner in consideration of the problems to be solved, supported by articulated reasoning with some rational underpinning to support the legal conclusion of obviousness in making the rejections of independent claims 1, 21, 24, 27 and 28 under the 35 USC obviousness statute.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James A. Kramer, can be reached on (571) 272-6783.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*

or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

June 11, 2007

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
*Aue 3692*